



AF/1617 # IFW

PATENT
Customer No. 22,852
Attorney Docket No. 05725-0306-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
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Boudiaf BOUSSOUIRA et al.) Group Art Unit: 1617
)
Application No.: 09/083,150) Examiner: Edward J. WEBMAN
)
CPA Filed: March 29, 2001)
)
For: COSMETIC USE OF SELECTED)
POLYAMINO POLYMERS AS)
ANTIOXIDANTS)
Mail Stop Appeal Brief--Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 1.193

Appellants respectfully submit this Reply Brief in triplicate under 37 C.F.R. § 1.193(b)(1) to the Board of Patent Appeals and Interferences in response to the Examiner's Answer, dated June 1, 2004. This brief is timely filed because the period for filing a Reply Brief extends to August 1, 2004.

I. Response to the Examiner's Answer

Appellants have considered the Examiner's Answer, which was mailed in response to Appellants' Appeal Brief filed February 25, 2004 ("Brief"). In view of the Examiner's Answer, Appellants have the following remarks.

The Examiner did not respond to Appellants' argument that there is no suggestion or motivation to choose the presently claimed at least one polyamino

polymer in combination with the presently claimed at least one nanopigment, let alone motivation for the selection of each component. As explained previously, *Wolf* cannot suggest or motivate the claimed polymer because it does not disclose the claimed polymer. Rather, *Wolf* discloses a carrier molecule complexed with a keratolytic compound. Moreover, nowhere does *Wolf* teach or suggest using its disclosed carrier molecules as antioxidants of “proteins, protein derivative, and lipids.” Brief at p. 13. *Fanchon* discloses a variety of active ingredients, but provides no suggestion or motivation to choose nanopigments for use in a composition with at least one polyamino polymer. See *Fanchon* col. 6, line 13-col. 7, line 34. As asserted in the Brief, without Appellants’ specification serving as a blue-print, no suggestion or motivation exists for Examiner’s § 103 rejections.

A. Objective Evidence of Suggestion or Motivation to Combine Is Absent

The Examiner focused on limited portions of the *Wolf* disclosure, thus failing to consider the *Wolf* reference in its entirety as required. M.P.E.P. § 2141.03. The Examiner focused only on the polymers disclosed by *Wolf* and ignored the fact that the disclosed polymers are used in a very specific manner. The failure to consider the *Wolf* reference as a whole is significant because the specific use of polymers taught by *Wolf* teaches away from the Appellants’ claimed invention. Brief at p. 13.

Wolf discloses a composition comprising “a keratolytic compound complexed to a carrier molecule.” Col. 1, lines 58-61; Brief at p. 9. As is readily apparent from reading the entire *Wolf* reference, the disclosure teaches only one use of those disclosed polymers—use as a carrier molecule for keratolytic compounds. Moreover, the polymers disclosed and claimed are those varieties of polymers suitable as carrier

molecules. Col. 2, lines 3-7, 35-37. Importantly, the disclosed suitable polymers are known polymers. Col. 2, lines 52-61, col. 3, lines 39-45. Thus, the novelty of the *Wolf* invention rests with the disclosed polymers complexing with keratolytic compounds to create a complex that "will remain stable in cosmetic preparations." Col. 2, lines 3-7.

As Appellants noted in their Brief, such a disclosure in *Wolf* teaches away from Appellants' invention. Brief at p. 13. Appellants' novel invention inhibits photo-oxidation of lipids induced by nanopigments and/or can inhibit the light-induced peroxidation of lipids and proteins, such as proteins of the skin. Brief at p. 4. *Wolf*'s disclosure of polymers as carrier molecules teaches away from Appellants' polyamino polymers serving as antioxidants of "proteins, protein derivatives, and lipids." Brief at p. 13.

Additionally, for the Examiner to properly combine *Wolf* with other references, such as *Fanchon*, he must point to where the references themselves provide the motivation, suggestion, or teaching to make the compositions claimed in Appellants' claims 1-28, 33-35, and 37. See *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Federal Circuit case law requires the Examiner to point to such motivation, suggestion, or teaching because "[m]ost if not all inventions arise from a combination of old elements . . . every element of a claimed invention may often be found in the prior art." *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000). *Wolf* does not provide the necessary guidance.

Nowhere does the *Wolf* disclosure teach or suggest which of the disclosed polymers can serve as antioxidants. Nowhere does the *Wolf* disclosure teach or suggest the use of polymers in a composition with nanopigments, as required by

Appellants' claim 1. And nowhere does the *Wolf* disclosure teach or suggest the use of polymers in an amount effective to inhibit light-induced peroxidation of proteins, protein derivatives, and lipids as required by Appellants' claim 37. In other words, one of ordinary skill in the art would not find any suggestion or motivation for Appellants' claims 1-28, 33-35, and 37 from *Wolf*.

Fanchon does not cure the deficiencies of *Wolf*. Brief at p. 10. First, it does not teach or suggest polyamino polymers. Second, the Examiner has not provided any evidence of suggestion or motivation to choose nanopigments from the various active ingredients disclosed in *Fanchon*. Col. 6, line 13-col. 7, line 34.

Thus, the Examiner has not put forth any objective evidence showing a suggestion or motivation to make a composition comprising a polyalkylenepolyamine and a nanopigment, or a composition comprising a polyalkylenepolyamine in an amount effective to inhibit light-induced peroxidation of proteins, protein derivatives, and lipids. The Examiner has also not put forth evidence showing a suggestion or motivation for choosing the polyamino polymers specified in Appellants' claims that have antioxidant properties to overcome the deficiencies present in the art before Appellants' invention. See Brief at pp. 3-4 for problems in the art.

As stated earlier, precedent requires that the suggestion or motivation to modify or combine references come from the prior art reference and not the Appellants' own disclosure. M.P.E.P. § 2143 (citing *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991)). The Examiner's burden is a heavy one, having to put forth "clear and particular" evidence of a teaching, suggestion, or motivation to modify or combine references. *In re Dembicziak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Examiner's rejections noted in

Appellants' Brief and the Examiner's response to Appellants' Brief clearly show that this burden has not been satisfied. Brief at p. 9. The Examiner's broad conclusory statements about the desirability of combining the two separately disclosed limitations is not in itself sufficient "evidence." *In re Dembiczak*, 175 F.3d at 999. There is simply no guidance in *Wolf* or *Fanchon* for the Appellants' invention found in claims 1-28, 33-35, and 37.

The only explanation for the Examiner's § 103 rejections lie in the improper use of Appellants' specification to reconstruct the claimed invention from isolated pieces of the prior art. Such hindsight analysis is strictly prohibited. M.P.E.P. § 2141.01(III) (citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983)).

Finally, the deficiencies of *Wolf* and *Fanchon* are not cured by referencing *Garrison*. The Examiner's reliance on *Garrison* solely for its disclosure of EDTA does not remedy the inabilities of *Wolf* and *Fanchon* to provide all the limitations of Appellants' claims and does not remedy their lack of a suggestion or motivation to combine their teachings for making the combination proposed by the Examiner. Therefore, the Examiner's rejection of claims 24 and 26 should be reversed and withdrawn.

For at least these reasons, Appellants respectfully request the Board reverse and withdraw the Examiner's § 103 rejections of Appellants' claims.

Respectfully submitted,

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